

AMENDMENT UNDER 37 C.F.R. § 1.111
US APPLN. NO. 09/628,168
ATTORNEY DOCKET NO. Q60267

REMARKS

Claims 1-8 have been examined on their merits.

Applicants herein editorially amend claims 2-4, 6 and 7 for reasons of precision of language. The amendments to claims 2-4, 6 and 7 were made merely to more accurately claim the present invention and do not narrow the literal scope of the claims and thus do not implicate an estoppel in the application of the doctrine of equivalents. The amendments to claims 2-4, 6 and 7 were not made for reasons of patentability.

Applicant herein adds new claims 9-22. Support for new claims 9-22 can be found, for example, in originally filed claims. Entry and consideration of the new claims 9-22 is respectfully requested.

The Examiner objects to claim 4 as being dependent upon a rejected base claim. Applicant thanks the Examiner for indicating that claim 4 would be allowed if rewritten in independent form. However, instead of rewriting claim 4 in independent form, Applicant respectfully traverses the prior art rejections for the reasons set forth below.

Claims 1-22 are all the claims presently pending in the application.

1. Claims 1 and 8 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Okano (Japanese Patent Publication No. Heisei 04-199123).¹ Applicant traverses the

¹ The Detailed Action section of the March 12, 2004 Office Action incorrectly refers to the Okano publication as JP 04-1999123.

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rejection of claims 1 and 8, and insofar as the rejection might apply to new claims 10-22, for at least the reasons discussed below.

As a threshold matter, the rejection of claims 1 and 8 based on the Abstract of Okano is improper. Citation of and reliance upon an abstract without citation of and reliance upon the underlying scientific document is generally inappropriate where both the abstract and the underlying document are prior art. *See Ex parte Jones*, 62 U.S.P.Q.2d 1206, 1208 (Bd. Pat. App. & Inter. 2001) (unpublished); MPEP § 706.02. The record must also be clear as to whether the Patent Office is relying upon the abstract or the full text document to support a rejection, since the full text document might include teachings away from the invention that will preclude an obviousness rejection under 35 U.S.C. § 103(a). *See* MPEP § 706.02.² When used to reject a claim, an abstract stands on its own and does not incorporate by reference any disclosure of the underlying document. *Ex parte Gavin*, 62 U.S.P.Q.2d 1680, 1683 (BAPI 2001). The preferred practice is for the Patent Office to cite and rely on the underlying document. *Id.* at 1684. Based on the March 12, 2004 Non-Final Office Action, it appears that the Patent Office is relying upon the Abstract of Okano, since no translation of the full text document of Okano was provided.

The initial burden of establishing that a claimed invention is *prima facie* obvious rests on the USPTO. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). To make its *prima facie* case

² When the Patent Office, as here, relies on a document that is in a foreign language, the Patent Office bears the burden of providing an English translation, at the latest, before forwarding the appeal to the Board. *Ex parte Bonfils*, 64 U.S.P.Q.2d 1456, 1460 (BAPI 2002).

of obviousness, the USPTO must satisfy three requirements:

- (i). The prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the artisan to modify a reference or to combine references. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988).
- (ii). The proposed modification of the prior art must have had a reasonable expectation of success, and that determined from the vantage point of the artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209 (Fed. Cir. 1991).
- (iii). The prior art reference or combination of references must teach or suggest all the limitations of the claims. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, the nature of a problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Alternatively, the motivation may be implicit from the prior art as a whole, rather than expressly stated. *Id.* Regardless if the USPTO relies on an express or an implicit showing of motivation, the USPTO is obligated to provide particular findings related to its conclusion, and those findings must be clear and particular. *Id.* A broad conclusionary statement, standing alone without support, is not “evidence.” *Id.*; *see also, In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

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In addition, a rejection cannot be predicated on the mere identification of individual components of claimed limitations. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Id.*

The Examiner acknowledges that Okano does not disclose a contrast control portion. *See* March 12, 2003 Non-Final Office Action, page 2. Furthermore, Okano fails to teach or suggest a contrast control portion that controls the contrast of scanned light according to an average level of an image signal, as recited in claim 1. The impressed voltage regulating means (15) of Okano controls the brightness of the liquid crystal display, and does not control the contrast of the liquid crystal display. More specifically, Okano regulates the light transmission through a liquid crystal display plate (11) to raise and lower its brightness, and this is accomplished by changing the voltage applied to a liquid crystal plate (14) with a variable resistor V_R . As is known in the art, contrast depends upon on the angle at which a liquid crystal display is viewed. When a liquid crystal display is viewed from an angle, the light issuing from the liquid crystal display is not coming out perpendicular from the liquid crystal display, so it is not uncommon to see a breakdown in the contrast. Under *Ex parte Gavin*, the Patent Office is limited to the disclosure of Okano, which only discusses controlling the brightness of a liquid crystal display, and not

controlling the contrast.³ Thus, Applicant submits that the Patent Office cannot fulfill the “all limitations” prong of a *prima facie* case of obviousness, as required by *In re Vaeck*.

Since Okano fails to disclose contrast control portion that controls the contrast of the optical image signal according to the brightness of the image signal, Applicant submits that one of ordinary skill in the art would not be motivated to modify the reference. *In re Dembiczak* and *In re Zurko* require the Patent Office to provide particularized facts on the record as to why one of skill would be motivated to modify a reference. Without a motivation to modify, a rejection based on a *prima facie* case of obviousness is improper. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998)). The level of skill in the art cannot be relied upon to provide the suggestion to modify a reference. *Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999). The Patent Office must make specific factual findings with respect to the motivation to modify a reference. *In re Lee*, 277 F.3d 1338, 1342-44 (Fed. Cir. 2002). Although the Patent Office alleges that the brightness controller of Okano can be used to change the contrast of the liquid crystal display, the abstract of Okano lacks any disclosure regarding contrast. As noted above, without a

³ The initial burden of establishing that a claimed invention is *prima facie* obvious rests on the U.S. Patent and Trademark Office. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). The U.S. Patent and Trademark Office is required to apply the law “in accordance with statute and precedent.” *In re Lee*, 61 U.S.P.Q.2d 1430, 1435 (Fed. Cir. 2002). The Patent Office is obligated under the Administrative Procedures Act to develop an evidentiary basis for its findings. *Id.* at 1434. As discussed *supra*, without a translation of the underlying text document of Okano, the Patent Office cannot make the hindsight argument that it would have been obvious to use Okano’s brightness controller for controlling contrast in order to reject independent claim 1. Moreover, the burden is on the Patent Office to make the *prima facie* case of obviousness, and the record must be complete. See MPEP § 706.02. In the instant application, the record is incomplete since no translation of Okano has been obtained, and it is not Applicant’s burden to obtain the translation. See MPEP § 706.02. Without a translation of the underlying text document of Okano, the Patent Office has no objective support for the rejection of independent claim 1.

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translation of Okano, the Patent Office is limited only to the abstract of Okano, and nothing else. Okano only discloses the adjustment of brightness of a liquid crystal display; there is no teaching or suggestion regarding the control of the contrast of an optical image signal according to the brightness of an image signal. Thus, Applicant submits that the Patent Office cannot fulfill the motivation prong of a *prima facie* case of obviousness, as required by *In re Dembiczak* and *In re Zurko*.

Based on the foregoing reasons, Applicant submits that Okano fails to teach or suggest all of the claimed elements as arranged in claim 1. Therefore, Okano clearly cannot render the present invention obvious as recited in claim 1. Thus, Applicant submits that claim 1 is allowable, and further submits that claim 8 is allowable as well, at least by virtue of its dependence from claim 1. Applicant respectfully requests that the Patent Office withdraw the § 103(a) rejection of claims 1 and 8.

With respect to new claims 10-16, Applicant submits that these new claims are allowable over Okano for at least the reasons discussed by the Patent Office in the Allowable Subject Matter section of the March 12, 2004 Non-Final Office Action. Applicant respectfully requests that the Patent Office indicate that new claims 10-16 are allowed in the next Communication from the Patent Office.

With respect to new claims 17-22, Applicant submits that these new claims are allowable over Okano for at least the same reasons as discussed above with respect to claims 1 and 8. Specifically, Okano fails to teach or suggest a contrast control portion that controls the contrast of the optical image signal according to an average level of the image signal, as recited in new

claim 17. For the sake of brevity, Applicant herein incorporates the above arguments with respect to claims 1 and 8 as being applicable to new claims 17-22. Applicant respectfully requests that the Patent Office indicate that new claims 17-22 are allowed in the next Communication from the Patent Office.

2. Claims 2, 3, and 5-7 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Okano in view of Helms (U.S. Patent No. 5,952,992). Applicant traverses the rejection of claims 2, 3 and 5-7 and new claims 9-22 for at least the reasons discussed below.

Claims 2, 3, 5-7 and new claim 9 depend from claim 1, and include all the recitations of claim 1 by virtue of their dependency from claim 1.

The combination of Okano and Helms fails to teach or suggest a contrast control portion as recited in claim 1, and included in claims 2, 3, 5-7 and 9 by virtue of their dependency. As discussed above, the Patent Office has not made a proper *prima facie* case of obviousness against Okano due to Okano's lack of teaching of a contrast control portion. The combination of Okano with Helms does not overcome the fundamental deficiencies of Okano. Although the Patent Office alleges that Helms discloses the requisite contrast control portion, the circuitry is actually a brightness control circuit that measures the ambient light level to control the brightness of a liquid crystal display. *See, e.g.*, Abstract, Figure 3 and cols. 3 and 4 of Helms. Neither Okano nor Helms discloses a contrast control portion receiving an average level of an image signal as recited by claim 1, and included via dependency in claims 2, 3, 5-7 and 9. Moreover, the brightness control circuit of Helms is responsive to ambient light, and not is not responsive to an

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image signal, as recited in claim 1. Thus, Applicant submits that the Patent Office cannot fulfill the “all limitations” prong of a *prima facie* case of obviousness, as required by *In re Vaeck*.

Applicant submits that one of skill would not be motivated to combine Okano with Helms. As discussed above, the brightness control circuit of Helms is responsive to the amount of ambient light near a liquid crystal display, and not to an image signal that is input to a liquid crystal display. Thus, Applicant submits that the Patent Office cannot fulfill the motivation prong of a *prima facie* case of obviousness, as required by *In re Dembiczak* and *In re Zurko*.

Based on the foregoing reasons, Applicant submits that the combination of Okano and Helms fails to teach or suggest all of the claimed elements as arranged in claim 1. Therefore, the combination of Okano and Helms clearly cannot render the present invention obvious as recited in claims 2, 3, 5-7 and 9. Thus, Applicant submits that claims 2, 3, 5-7 and 9 are allowable, and respectfully requests that the Patent Office withdraw the § 103(a) rejection of claims 2, 3 and 5-7.

With respect to new claims 10-16, Applicant submits that these new claims are allowable over the combination of Okano and Helms for at least the reasons discussed by the Patent Office in the Allowable Subject Matter section of the March 12, 2004 Non-Final Office Action. Applicant respectfully requests that the Patent Office indicate that new claims 10-16 are allowed in the next Communication from the Patent Office.

With respect to new claims 17-22, Applicant submits that these new claims are allowable over the combination of Okano and Helms for at least the same reasons as discussed above with respect to claims 2, 3 and 5-7. Specifically, the combination of Okano and Helms fails to teach

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or suggest a contrast control portion that controls the contrast of the optical image signal according to an average level of the image signal, as recited in new claim 17. Applicant respectfully requests that the Patent Office indicate that new claims 17-22 are allowed in the next Communication from the Patent Office.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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CUSTOMER NUMBER


Paul J. Wilson
Registration No. 45,879

Date: June 8, 2004